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10/848,802	05/19/2004	William Herbert Starnes JR.	EP-1020-CIP-CON	6244

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EXAMINER

SZEKELY, PETER A

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1714

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/848,802
Filing Date: May 19, 2004
Appellant(s): STARNES ET AL.

Daniel J. Hudak, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/21/06 appealing from the Office action
mailed 8/1/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows: The rejection of claims 41 and 42 under 35 U.S.C. 112 is withdrawn by the examiner due to applicants' response. These claims are now objected to for depending from a rejected claim, but would be allowable if they were independent claims incorporating all the limitations from the claims they depend from.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: See withdrawn rejections.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Rejection of claims 41 and 42 under 35 U.S.C. 112, first paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

DE 3247736	Henkel KGaA	7-1984
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Henkel KgaA DE 3247736.

Henkel reveals applicants' thiol compound in claims 8 and 9 and thiol stabilized halogen-containing polymer in claims 1, 3 and 4. Epoxidized soybean oil can be found on page 12, lines 19-20 and page 23, line 12. Appropriate alcohols are listed on page 7, lines 17-21. Applicants' claims are not novel.

(10) Response to Argument

Applicants' arguments filed 12/21/06 have been fully considered but they are not persuasive. Henkel claims three different embodiments of a stabilized polyvinyl chloride composition. Claims 1, 8 and 9 claim PVC and thiol containing stabilizer, claims 2, 5 and 10 are claiming PVC, thiol compound and metal containing stabilizer and claims 6, 7, 11 and 12 are claiming PVC, thiol compound, metal containing stabilizer and sodium aluminosilicate. The English translation of the German patent makes this clear in the

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first full paragraph on page 7 of the specification describing the first embodiment, while the paragraph overlapping pages 6 and 7 and the first full paragraph on page 8 teach the second embodiment and the third embodiment is discussed in the second and third paragraphs of page 11 and the paragraph overlapping pages 11 and 12. Claims 8 and 9 even claim a stabilizer combination of two thiol compounds without mentioning metallic soaps. The examiner does not argue that the reference does not show a preference for a combination of metallic soap and thiols. There is no question that the Illustrative Examples all disclose metal containing stabilizers. However, references must be considered for all they disclose and must not be limited to their preferred embodiments or working examples. See: *In re Mills*, 176 USPQ 196 (CCPA 1972). When a reference specifically and individually claims a specific combination of ingredients, in this case the thiol compounds and PVC in claims 1, 8 and 9, without mentioning metal containing stabilizers, it is not possible to maintain the argument that the reference does not show possession of the inventive composition of a halogen containing polymer and a thiol compound.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peter Szekely



Primary Examiner

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